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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,981	03/14/2002	Florence L'Alloret	220760USOPCT	2976
22850	7590	07/15/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EGWIM, KELECHI CHIDI	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/069,981

Applicant(s)

L'ALLORET, FLORENCE

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/4/2005 & 4/25/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-69 is/are pending in the application.
- 4a) Of the above claim(s) 27,31,34,35,37,38,46-48,50-53,56-60 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25,26,28-30,32,33,36,39-45,49,54,55,61 and 63-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 042505.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if applicant is claiming a block polymer, a graft polymer, either or both.

### ***Claim Rejections - 35 USC § 102***

3. Claims 25, 26, 28, 30, 32, 33, 40-45, 49, 55 and 65-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Merchant Jr. et al., for reasons stated in previous Office Actions.
4. Claims 25, 26, 28, 29, 33, 40-45, 49, 55 and 65-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Koerner et al., for reasons stated in previous Office Actions.

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5. Claims 25, 26, 28, 29, 32, 33, 39-45, 49, 55 and 63-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Fogel et al., for reasons stated in previous Office Actions.

***Claim Rejections - 35 USC § 103***

6. Claims 25, 26, 28-30, 32, 33, 36, 39-45, 49, 54, 55, 61, 63, 64 and 65-69 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Maroy et al., for reasons stated in the previous Office Action.

While Maroy et al., do not expressly teach the disclosed LCST demixing temperatures as claimed, it is reasonable that the LCST units of Maroy et al., would possess the presently claimed properties since the LCST units are identical to applicants and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition is not patentable regardless of any new or unexpected properties. In re Fitzgerald et al , 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 25, 26, 28-30, 32, 33, 36, 39-45, 49, 54, 55, 61, 63, 64 and 65-69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of 44-46, 104, 110, 116, 119, 125, 126, 131, 134-136 and 143-144 copending Application No. 10/069,983. Although the conflicting claims are not identical, they are not patentably distinct from each other because you cannot carry out the method of 10/069,983 without having the product of the present claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

9. Applicant's arguments filed 06/22/05 have been fully considered but they are not persuasive.

10. Applicant states that "Merchant describes a maleic anhydride grafted to an alkyl phenol formaldehyde resin", however, this only one of the LCST containing water-soluble polymer taught in Merchant, including oxyalkylated amines, glycol resin esters, oxyalkylated polyols and oxyalkylated alky-phenol formaldehyde resins. The oxyalkylated alky-phenol formaldehyde resins (taught in col. 6) of Merchant are not limited to the p-nonyl phenyl formaldehyde resin of Example 1.

11. Regarding, Koerner the particular polymer of example 8 has a cloud point at a higher concentration than the concentration recited in the claims. These are not the same concentrations for lack of a cloud point required in applicant's claims. Also, col. 5, lines 27-34 list other LCST containing water-soluble polymer that satisfy the structural requirements of the polymers in the rejected claims.

12. Regarding Fogel, applicant appears to be ignoring the polyoxyethylene portions of the water-soluble polymers, i.e. y is from 1 to 20. The reference itself teaches cloud points less than about 15°C, which is well within the range recited in the present claims.

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Regarding the Maroy publications, the Examiner fails to find any specific teachings of demixing temperatures above 40°C at 1% by mass in water as suggested by applicant. However, as state above, it is reasonable that the LCST units of Maroy et al., would possess the presently claimed properties since the LCST units are identical to applicants. An otherwise old composition is still not patentable regardless of any new or unexpected properties.

13. The following prior art, made of **record** but not relied upon, are considered pertinent to applicant's disclosure: Yeung et al. (WO 00/35961) and Hourdet et al., "Synthesis of the thermoassociative copolymers" POLYMER, Vol. 38 No. 10, pp. 2535-2547 (1997).

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE

  
KELECHI C. EGWIM PH.D.  
PRIMARY EXAMINER